

Application Serial No. 10/628,974
Amendment dated February 1, 2005
Reply to Office Action dated October 5, 2004

REMARKS

Claims 1-12 are pending in the application. Claims 1-12 are rejected in the present Office Action. Claims 1 and 7 are presently amended. In view of these amendments, and the discussion below, Applicant believes that the application is now in condition for allowance.

Double Patenting Rejections

Claims 1-5 are rejected under the judicially-created doctrine of double patenting over claims 1-9 of Metzger (U.S. Patent No. 6,620,140). While Applicant submits the rejection is in error, for the sole purpose of expediting prosecution, Applicant submits herewith a terminal disclaimer, thus rendering moot the rejection of claims 1-5 for obviousness-type double patenting.

Claim Rejections 35 U.S.C. §§ 102 and 103

Claims 1-3 and 7-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dysarz (U.S. Patent No. 5,935,113). Claims 4 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dysarz. Claims 5, 6, 10, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dysarz in view of Cirelli (U.S. Patent No. 5,848,990). Applicant submits that the cited reference fails to teach the invention of independent claims 1 and 7, such that all of the rejections must fall.¹

¹Applicant will focus the discussion on independent claims 1 and 7 as that is believed to be dispositive. Applicant reserves the right to address the dependent claims separately should the need arise.

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Examiner points to Dysarz, and particularly Figs. 5 and 6 thereof, as disclosing an apparatus having an elongated capsule 9 (which the Examiner calls a housing), a hard cannula 37 (which the Examiner calls a movable needle), a piston base 27 (which the Examiner calls a second moveable member), a spring 25, a piston stop 13 (which the Examiner call a retention mechanism), and a latch bar 8 (which the Examiner calls a trigger) for activating a release mechanism. Examiner thus suggests that Dysarz discloses all limitations of independent claims 1 and 7. Applicant respectfully disagrees.

Claim 1, as presently amended, recites that the second moveable member moves "repeatedly" between a retracted position (wherein the first moveable member does not fluidly communicate with the port) and an extended position (wherein the first moveable member fluidly communicates with the port). Dysarz does not disclose a moveable member that moves repeatedly between such retracted and extended positions. Referring to Figs. 5 and 6 of Dysarz, the hard cannula 37 and piston 22 are originally held in an extended position. Once the latch bar 8 is depressed (as in Fig. 6), the bias of the spring 25 forces the piston 22 and hard cannula 37 to a retracted position. As can be seen in Figs. 4, 6, and 7 (all of which depict the apparatus in the retracted position), once in the retracted position, the piston 22 and hard cannula 37 are encapsulated by the elongated capsule 9. In such a position, the piston 22 and hard cannula 37 cannot be re-extended. Not only is it clear from the Figures that it is

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impossible to do this, nowhere does the specification of Dysarz teach or even suggest this possibility.

Further, Dysarz does not disclose a "retracted position" and an "extended position" as those terms are used in claim 1. In the embodiment of Figs. 4 and 6 of Dysarz, the hard cannula 37 fluidly communicates with the port when in a retracted position, whereas claim 1 recites that in the retracted position "the first moveable member does not fluidly communicate with the port." Hence, the embodiment of Figs. 4 and 6 cannot anticipate the invention of claim 1. In the embodiment of Fig. 7 of Dysarz, the hard cannula 37 does not fluidly communicate with the port in the retracted position, because a portion of the hard cannula 37 has been permanently broken. However, even if one could re-extend the hard cannula 37 (which Applicant submits, as above, they could not), it would not then be able to fluidly communicate with the port since the hard cannula 37 has been destroyed. Claim 1, however, recites that in the extended position "the first moveable member fluidly communicates with the port." Hence, the embodiment of Fig. 7 also cannot anticipate the invention of claim 1.

Claim 1 is also not obvious over Dysarz because one would have to drastically modify the apparatus of Dysarz in order to obtain the apparatus as recited in claim 1 of the present application. One would not be motivated to make the necessary modifications because the apparatus of Dysarz is adapted for a single use, whereas the apparatus of the present invention is adapted for multiple uses. More specifically, Dysarz provides an apparatus having a hard cannula 37 that is retracted into an

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elongated capsule 9 following a single use to protect a user against inadvertent needle sticks. It is not designed to thereafter be re-extended. Re-extending the hard cannula 37 would require either adding a separate mechanism to move the hard cannula 37 from the retracted to the extended position, or would require breaking open the elongated capsule 9 to have access to re-extend the hard cannula 37. In either case, such a modification would be completely antithetical to the purpose of Dysarz. Allowing the re-extension of the hard cannula 37 of Dysarz would also allow the possibility of inadvertent needle sticks, which Dysarz seeks to prevent. There is simply no motivation to modify the apparatus of Dysarz in a manner to defeat the purpose of Dysarz.

Claim 7, as presently amended, recites that the moveable member is "returnable to the extended position after being returned to the retracted position." Dysarz does not disclose a moveable member that is returnable to the extended position after being returned to the retracted position. As described above, once the latch bar 8 of Dysarz is depressed, the bias of the spring 25 forces the piston 22 and hard cannula 37 into the capsule 9 where they are encapsulated. In such a position, the piston 22 and hard cannula 37 cannot be returned to an extended position. Not only is it clear from the Figures that it is impossible to do this, nowhere does the specification of Dysarz teach or even suggest this possibility. Further, for the reasons discussed above with respect to the nonobviousness of claim 1, claim 7 is also nonobvious over Dysarz, because the apparatus of Dysarz is adapted for a single use. Thus, there would be no motivation to modify the apparatus of Dysarz to add a

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mechanism or break open the capsule 9 as would be required to allow for re-extension of the hard cannula once it has been retracted. To do so would be antithetical to the purpose of Dysarz.

In view of the amendments to claims 1 and 7, and the discussion above, Applicant asserts that claims 1 and 7 of the present application are not anticipated by nor rendered obvious by Dysarz. As such, the rejection of the claims under 35 U.S.C. § 102(b) and/or § 103 should be withdrawn.

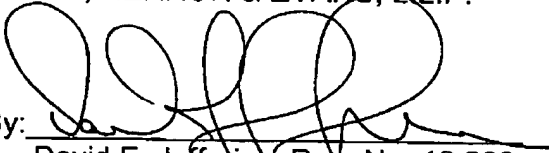
Conclusion

In view of the present amendments, it is believed that all claims are allowable, and a Notice of Allowance is respectfully requested.

The Examiner is invited to contact the undersigned attorney with any questions or remaining issues.

Respectfully submitted,

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